

REMARKS

In the Office Action¹, the Examiner rejected claims 14-16 under 35 U.S.C § 101; rejected claims 1-9 under 35 U.S.C § 112, second paragraph; rejected claims 1, 4, 6-8, 10-12, 14, and 15 under 35 U.S.C § 102(b) as being anticipated by U.S. Patent No. 5,798,921 to Johnson et al. ("*Johnson*"); and rejected claims 2, 3, 5, 9, 13, and 16 under 35 U.S.C § 103(a) as being unpatentable over *Johnson* in view of U.S. Published Patent Application No. 2003/0058781 to Millikan et al. ("*Millikan*").

By this amendment, Applicant amends claims 1, 3, 8-10, 13, 14, and 16. Claims 1-16 remain pending.

Applicant respectfully traverses the rejection of claims 14-16 under 35 U.S.C § 101 as being directed to non-statutory subject matter. However, in order to expedite prosecution, Applicant has amended independent claim 14 to recite, "[a] computer readable media storing a computer program that causes a processor to perform a method." Independent claim 14 is directed to statutory subject matter, and accordingly, the Examiner should withdraw the rejection of claim 14, and dependent claims 15 and 16, under 35 U.S.C § 101.

Applicant respectfully traverses the rejection of claim 1-9 under 35 U.S.C § 112, second paragraph as being indefinite. The Examiner alleges that independent claims 1, 4, 8, and 9 invoke 35 U.S.C § 112, sixth paragraph, and therefore, "require limitation of the claim to the corresponding structure recited in the specification or its equivalent. However, because the specification fails to identify structures corresponding to the

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

means claimed, the claims is indefinite.” (Office Action, page 2, ¶ 5). However, “structures corresponding to the means claimed,” are disclosed in Applicant’s disclosure, for example Figure 1, and pages 9 and 10 of the specification. Accordingly, the Examiner should withdraw the rejection of claims 1-9 under 35 U.S.C § 112, second paragraph.

Applicant respectfully traverses the rejection of claims 1, 4, 6-8, 10-12, 14, and 15 under 35 U.S.C § 102(b) as being anticipated by *Johnson*. *Johnson* fails to teach all features of the claims.

For example, claim 1 recites “[a]n audio playback apparatus,” including “playback means for reproducing the music files included in the selected music file group before reproducing music files that are not in the selected musical file group.” *Johnson* fails to teach or suggest, for example, the claimed “playback means.”

Instead, *Johnson* is directed to “[a]n audio system ... wherein music cartridges are utilized in a series of cartridge racks for non-mechanical playback and recordation of an entire music collection,” (*Johnson*, Abstract). In the system, “an album screen is displayed 148 ... The user may choose to play the entire selection 151, a particular album 152, or choose random play 153,” (*Johnson*, col. 9, lines 10-16). If the user wants random play, “[t]he random selection process 220 will begin by the player 20 generating a random number and then using that number to choose an album. It will then display the songs of that selection, generate another random number and use that number to choose one of the songs displayed. It will play that song, and then reiterate this process until the stop button of the player is activated,” (*Johnson*, col. 10, lines 55-63).

The Examiner appears to allege that the album chosen using a random number from *Johnson* constitutes the claimed “selected music file group.” However, this is incorrect because *Johnson* is not “reproducing the music files included in the” randomly selected album (alleged “selected music file group”) “before reproducing music files that are not in the” randomly selected album, as recited by claim 1. Instead, the album from *Johnson* is randomly selected in order to access a group of songs, and a particular song is selected based on another random number. Once the song is finished playing, another album is randomly selected (*Johnson*, col. 10, lines 59-61).

In *Johnson*, it may be possible that all music files in a selected album eventually play if the user allows the random feature to play long enough. However, this does not constitute “playback means for reproducing the music files included in the selected music file group before reproducing music files that are not in the selected musical file group,” as recited in claim 1, since songs from other albums in *Johnson* would be played before all songs in a selected album were played. Accordingly, and for at least these reasons, *Johnson* fails to anticipate claim 1.

Independent claims 8, 10, and 14, while of different scope than claim 1, distinguish over *Johnson* for at least the same reasons as claim 1.

Claims 4, 6, 7, 11, 12, and 15 depend from one of claims 1, 10, and 14. Accordingly *Johnson* fails to anticipate claims 4, 6, 7, 11, 12, and 15.

Applicant respectfully traverses the rejection of claims 2, 3, 5, 9, 13, and 16 under 35 U.S.C § 103(a) as being unpatentable over *Johnson* in view *Millikan*.

Independent claim 9 recites, “[a]n audio playback apparatus,” including “playback means for reproducing the music files in the selected folder before reproducing music

files that are not in the selected folder.” *Johnson* fails to disclose the claimed “playback means.”

Millikan fails to cure the deficiencies of *Johnson*. *Millikan* fails to teach or suggest, “playback means for reproducing the music files in the selected folder before reproducing music files that are not in the selected folder,” as recited by claim 9. Accordingly, *Johnson* and *Millikan*, whether taken alone or in combination, fail to disclose the subject matter of claim 9.

Claims 2, 3, 5, 13, and 16 depend from one of independent claims 1, 10, and 14. Accordingly, *Johnson* and *Millikan* fail to disclose the subject matter of claims 2, 3, 5, 13, and 16.

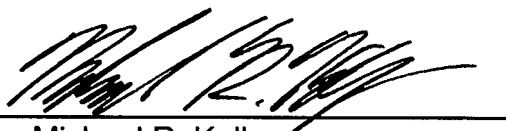
In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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